

REMARKS/ARGUMENTS

The Examiner had delineated the following inventions as being patentably distinct.

Group I: Claims 1-9, drawn to a dispersion or solution of a polymer having 3,4-dihydroxyphenyl group;

Group II: Claims 10-13, drawn to a method of using the dispersion of a polymer having 3,4-dihydroxyphenyl group; and

Group III: Claims 14-16, drawn to a specific free radically polymerizable monomer having 3,4-dihydroxyphenyl group.

Applicants provisionally elect with traverse the invention of Group II (Claims 10-13) directed to a method of using the dispersion or solution.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (M.P.E.P. § 803). The burden of proof is on the Examiner to provide reasons and/or examples to support any conclusions that the claims for the restricted groups are independent patentably distinct.

The claims of Groups I-III are related as product, and method of using, and as such are considered interdependent and should be examined together, especially wherein the sole disclosed utility of the product is that recited in the specification.

Unity of invention has to be considered in the first place only in relation to the independent claim. A dependent claim is one which contains all of the features of another claim and is in the same category of claims as other claims. It does not matter if a dependent claim itself contains a further invention.

There is a commonality that exists between the groups. It is a technical relationship that defines the contribution which each of the groups, taken as a whole, makes over the prior art.

Different classification of subject matter to be divided is not conclusive proof of independent status and divisibility. Product, and method of use are related inventions under 37 C.F.R. § 1475(b) and unity of invention between the groups exists.

Applicants respectfully traverse on the additional ground that the Office has not shown that a burden exists in searching the entire application.

Further, M.P.E.P. § 803 states as follows:

If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on its merits even though it includes claims to distinct and independent invention.

Applicants submit that a search of all the claims would not constitute a serious burden on the Office. In fact, the International Search Authority has searched all of the claims together. As the Office has not shown any evidence that a restriction should now be required when the International Preliminary Report did not, the restriction is believed to be improper. 37 C.F.R. § 1.475(b) provides in relevant part that at a “national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn to ---(3) a product, process and method of use.”

For the reasons set forth above, Applicants request that the restriction requirement be withdrawn.

Applicants further request that if the invention of Group II is found allowable, withdrawn Groups I and III which includes the limitations of the allowable claims be rejoined.

Respectfully submitted,

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